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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 21 2000

Patentee: Rozmanith et al.

TC 2800 MAIL ROOM

Patent No. 5,253,341

Issued: October 12, 1993

For REMOTE QUERY COMMUNICATION SYSTEM

Attorney's Docket 0929-0088P

JUL 20 2000

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Director, and Assistant Secretary of Commerce
United States Patent and Trademark Office
Washington DC 20231

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Request for Reexamination at the Initiative of the Director

It is hereby requested that the Director of the Patent and Trademark Office, pursuant to 37 C.F.R. 1.520, on his own initiative order the reexamination of United States patent No. 5,253,341 to Rozmanith et al. (the "Rozmanith et al. patent").

Claim 1 of the Rozmanith patent, the patentability of which strains the credulity to which it relates, even of persons who are not skilled in the particular art, as claiming something that is not entitled to patentability:

"A method for downloading responsive data from a remote server comprising the following steps:
identifying a query via a data input means and inputting said query to remote query and data retrieval means;
transmitting said query from said remote query and data retrieval means to a remote host via an input/output means;
receiving a compressed or non-compressed response to said query at said remote query and data retrieval system from said remote host via said input/output means; and
displaying a presentation corresponding to said query response on output means.

Reexamination of the Rozmanith et al. patent was earlier requested under Reexamination Control No. 90/005742, and also by the undersigned filed concurrently herewith. The request filed in the aforesaid earlier reexamination, includes some weighty facts that have no legal relevance for a reexamination request by a third party, but they are

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of sufficient significance warranting consideration by the Director in determining whether to order reexamination of the Rozmanith et al. patent on his own initiative. For that reason, **this request** although originating from outside the Patent and Trademark Office, that the Director undertake reexamination on his own initiative, should be considered in view of its great impact on the public interest. The effect of the Rozmanith et al. patent and the reprehensibly aggressive licensing practices associated with it are even more pervasive to the internet using web community than the Y2K patent which is being reexamined on the Director's initiative. In support of this request, the undersigned reproduces portions **that are pertinent to this kind of request**, from the reexamination request filed under Reexamination Control No. 90/005742.

"After acquiring ownership of the '341 patent in 1998, TechSearch (the owner of the Rozmanith et al. patent) began asserting the '341 patent against web site owners by alleging that the mere operation of a web site constituted infringement. As part of its licensing strategy, TechSearch has filed patent infringement actions against at least eleven companies based on the '341 patent (including United Airlines, Hyatt, Walgreens, and Sears), and threatened countless more with litigation.

Currently pending patent infringement actions include: TechSearch L.L.C. v. Walgreens Co., No. 99-CV-7486 (N.D. Ill., filed Nov. 16, 1999) (Other named defendants are Sears, Roebuck & Co.; Encyclopedia Britannica, Inc.; Audible, Inc.; and Bigstar Entertainment, Inc. It is believed that all defendants except Sears have settled.); and TechSearch L.L.C. v. Sara Lee Corp., No. 00-CV-1207 (N.D. Ill., filed Feb. 29, 2000) (Other named defendants are Allstate Corp.; Euromarket Designs, Inc.; Harrah's Entertainment, Inc.; and Replay TV, Inc.).

Other patent infringement actions filed by TechSearch that have subsequently settled include: TechSearch L.L.C. v. United Air Lines, Inc., No. 99-CV-4550 (N.D. Ill., filed July 9, 1999) (Other named defendants are Spiegel, Inc. and Hyatt Corp.); and TechSearch L.L.C. v. FTD.com, Inc., No. 99-CV-6795 (N.D. Ill., filed Oct. 15, 1999).

By its actions, TechSearch has demonstrated its intent to assert the '341 patent against anyone who operates a web site.

TechSearch's conduct impacts thousands of companies throughout the country and the world who rely on a web site to support their businesses. Particularly disturbing is TechSearch's practice of directing its enforcement efforts at young technology companies filing registration statement for initial public offerings. The risk of patent litigation may jeopardize these companies' opportunity to obtain critical financing. Typically, the risk of

losing financing forces these companies to take a license from TechSearch despite their substantial concerns regarding the validity and infringement of the '341 patent. TechSearch, apparently aware of the weakness of its patent, offers a fully-paid up license under the '341 patent for only \$35,000. The low licensing fee (compared to the cost of patent litigation) makes it economically impractical for these companies to challenge the '341 patent in court.

Clearly, TechSearch's actions, in attempting to assert the '341 patent against web site owners, pose a serious risk to the web community. For these reasons as well as the reasons discussed below, it is imperative that the PTO proceed with a reexamination of the '341 patent."

The undersigned attorney has information about considerably higher licensing offers than the aforementioned \$35,000, but still below the estimated cost of a fraction of full blown litigation to establish invalidity.

These kind of abusive, extortionate attempts for generating licensing income by asserting invalid patents at "paid up" licensing fees which would discourage litigating the validity of patents that appear to be invalid on their face, has become a feature of unprincipled patent enforcement by those who have initially obtained broad patents in the data processing and business methods fields. These are new areas of technology in which the Patent and Trademark Office has not yet acquired the proficiency to do a full and complete, high quality search as it is capable of doing in almost any other technical field.

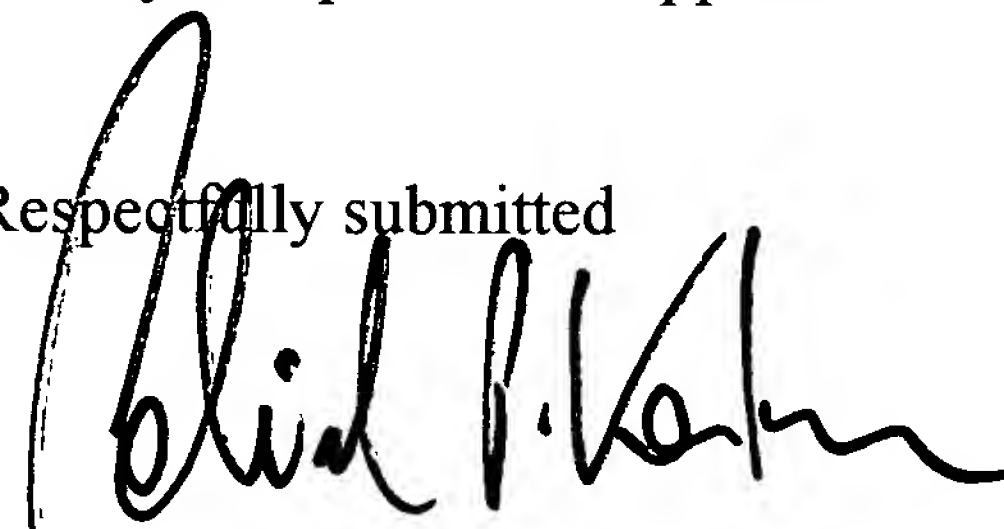
In public discussions about these licensing attempts, the Rozmanith et al. patent (also referred to as the "TechSearch patent") has become emblematic of abusive licensing practices.

The asserting of facially invalid patents under economic conditions that do not warrant a validity challenge in the courts, and the unavailability of a meaningful *inter partes* reexamination against the Rozmanith et al. patent, represent an embarrassment to the patenting process. This should be of particular relevance to the agency entrusted with carrying out that process. It is therefore, respectfully requested that the Director lend the prestige of his office to the process of reexamining the validity of a patent that appears invalid on its face.

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Respectfully submitted



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